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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,005	01/18/2002	Thierry Barboux	GASQ-101	1229

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EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 12/30/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,005

Applicant(s)

BARBOUX

Examiner

Anthony D Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 13-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 contains the phrase "the sole" in lines 2 and 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 1 also contains the phrase "the boot" in lines 3 and 5 of the claim. There is insufficient antecedent basis for this limitation in the claim, as applicant has not claimed the boot, only intended use. Also, it is unclear as to whether applicant is claiming the sole insert, the boot for use in a snowshoe, or the snowshoe or any combination thereof.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3728

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 13-18, 21, 23-24, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipate by McKenzie et al. 5,493,794. McKenzie et al. '794 discloses all the limitations of the claims including the following: (see especially Figure 7A) a sole insert (40 including 42-45) that runs transverse a sole of a boot (see Figure 7A, boot is 34 as this is a snowshoe boot/binding); the insert having two ends (left and right ends of 40); each end positioned on a lateral edge of the sole (the sole is 46a, 46b); the length of the sole insert is independent of the size of the boot and is designed to be used on at least two different boot sizes (length of insert is designed to fit between the rails 18, 20 independent of the boot size); the length of the sole insert is the same for at least two boots of different sizes (length of insert is designed to fit between the rails 18, 20, independent of the boot size); each end of the sole insert comprises hollow compartments (see 45 in Figure 7A); a boot having the sole insert (boot is 34); the sole insert is positioned along a transverse axis that is orthogonal to a longitudinal axis of the boot (see Figure 7A); the longitudinal position of the sole insert is the same for a given boot model,

Art Unit: 3728

regardless of the size of the boot (insert designed to fit between rails); the sole has hollow contours on its lateral edges in which the ends of the sole insert are located (see Figure 4); the sole insert is positioned in the sole such that the ratio between the distance measured between the transverse axis of the sole insert and the front end of the boot and the length of the boot is the same regardless of the size of the boot (sole insert is designed to position between the rails 18 and 20); the process for manufacturing the boot comprises arranging an insert inside the sole of a boot, the insert having a length that is independent of the size of the boot and is constant (see Figure 4); the sole insert of one boot has the same length as the sole insert of another boot (insert designed to fit between rails 18 and 20, independent of shoe size); the sole insert is curved (tubular); the sole insert having hollow ends (holding elements, see 45 in Figure 7A)).

5. Claims 13-18, 20-21, 23-24, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipate by Massicotte 3,344,538.

Massicotte '538 discloses all the limitations of the claims including the following: a sole insert 41 that runs transverse a sole of a boot (see Figure 4); the insert having two ends (one on each side of the sole); each end positioned on a lateral edge of the sole (see Figure 4); the length of the sole insert is

Art Unit: 3728

independent of the size of the boot and is designed to be used on at least two different boot sizes (sole insert designed to fit between lock plate 16 and block 17); the length of the sole insert is the same for at least two boots of different sizes (sole insert designed to fit between lock plate 16 and block 17); each end of the sole insert comprises hollow compartments (see Figure 4, pin fits in hollow compartment); a boot having the sole insert (Figures 2 and 2a); the sole insert is positioned along a transverse axis that is orthogonal to a longitudinal axis of the boot (see Figure 1); the longitudinal position of the sole insert is the same for a given boot model, regardless of the size of the boot (sole insert designed to fit between lock plate 16 and block 17); the sole has hollow contours on its lateral edges in which the ends of the sole insert are located (pins for locking fit in hollow ends); the width of the sole varies in its height (see Figures 2 and 2A) and a vertical position of the sole insert differs depending on the size of the boot (see Figures 2 and 2A); the sole insert is positioned in the sole such that the ratio between the distance measured between the transverse axis of the sole insert and the front end of the boot and the length of the boot is the same regardless of the size of the boot (sole insert designed to fit between lock plate 16 and block 17, regardless of size of boot);

Art Unit: 3728

the process for manufacturing the boot comprises arranging an insert inside the sole of a boot, the insert having a length that is independent of the size of the boot and is constant (see Figures 1-7); the sole insert of one boot has the same length as the sole insert of another boot (sole insert designed to fit between lock plate 16 and block 17, regardless of size of boot); the sole insert is curved (tubular); the sole insert having hollow ends (holding elements, see Figure 4).

6. Claims 13-19, 21-24 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by the WO reference to Aomori WO00/13538 (WO '538). WO '538 discloses all the limitations of the claims including the following: a sole insert 26 that runs transverse a sole of a boot (see Figure 5); the insert having two ends (see Figure 5); each end positioned on a lateral edge of the sole (as shown in Figures 4-7); the length of the sole insert is independent of the size of the boot (designed to fit between the binding G shown in Figure 8, independent of the size of the boot and can be used on any boot size) and is designed to be used on at least two different boot sizes; the length of the sole insert is the same for at least two boots of different sizes (insert is designed to fit binding G independent of boot size); each end of the sole insert comprises hollow compartments (see Figure 4, end caps 28 screw into hollow ends of insert 26);

Art Unit: 3728

a boot having the sole insert (see Figure 4); the sole insert is positioned along a transverse axis that is orthogonal to a longitudinal axis of the boot (see Figures 5-7); the longitudinal position of the sole insert is the same for a given boot model, regardless of the size of the boot (longitudinal position depends upon the location of the hole in the sole rather than the length of the boot. Boots designed to fit the binding G would have holes in the sole in the same place irregardless of size of boot); the sole has hollow contours on its lateral edges in which the ends of the sole insert are located (see Figure 4, hollow ends accept plugs 28); a longitudinal position of the sole insert varies as a function of size whereby the sole insert is positioned in a front part of the boot at a point where the width of the sole is equal to the length of the sole insert (see Figures 5-7); the sole insert is positioned in the sole such that the ratio between the distance measured between the transverse axis of the sole insert and the front end of the boot and the length of the boot is the same regardless of the size of the boot (see Figure 4); the process for manufacturing the boot comprises arranging an insert inside the sole of a boot, the insert having a length that is independent of the size of the boot and is constant (Inserts are designed to fit in binding G independent of the size of the

Art Unit: 3728

boot); the sole insert of one boot has the same length as the sole insert of another boot (left and right boots of a pair are the same); the sole insert is curved (tubular); the sole insert having hollow ends (holding elements, see Figure 4).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being obvious over any one of the references as applied to claim 13 above. With respect to claim 25, the change in size and shape does not lead to Patentability. Therefore, to make any of the inserts of the references as applied above flat would be well within the skill of one of ordinary skill in the art. With respect to claim 26, to make the insert of any one of the references as applied to claim 13 above, out of material that is typically used in making of boots, i.e. thermoplastic material, to keep the desired flexibility, would have been well within the

Art Unit: 3728

skill of one of ordinary skill in the art at the time the invention was made.

Response to Arguments

9. Applicant's arguments filed October 9, 2003 have been fully considered but they are not persuasive. Applicant argues that McKenzie does not disclose a sole. This argument is not clearly understood. The sole plate of the binding is the sole of the "snowshoe boot" and the straps of the binding constitute an upper. Therefore, the inboard and outboard portions 46a and 46b, of the binding is the sole of the boot. Therefore, pivot member 40 is located within the sole of the boot. Applicant further argues that Massicotte does not disclose that the length of the sole insert is independent of the size of the boot. This argument is not clearly understood. The insert of Massicotte is made to be placed between lock plate 16 and block 17 whose size and location is independent of the shoe size, as it is not limited by the size of the shoe. With respect to applicants arguments directed to the second McKenzie rejection, this rejection was supposed to have been with respect to Rieker, not McKenzie, but has nonetheless been withdrawn based on the rejections above. Lastly, applicant argues that the rejection with respect to Aomori (WO '538) is directed to a surfboard and

Art Unit: 3728

not a snowshoe. This argument is not clearly understood. Applicant has not claimed the snowshoe and has only claimed the functional relationship with a snowshoe. Since the Boot of Aomori can perform as claimed, it meets the limitations of the claims. Once again, with respect to the sizing of the insert, this argument is addressed in the rejections above.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3728

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Art Unit: 3728

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/



Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS

December 29, 2003